

REMARKS

Claims 1-4, 6, 7, 9 and 10 have been rejected under 35 U.S.C. 112, second paragraph as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants respectfully traverse.

On page 2, sections 1-2 under the heading "Claim Rejections", no explanation of the rejection is provided. On page 6 of the Office Action under the heading "Response to Remarks", section 3, the Examiner states that the rejection of claims 1-4, 6, 7 and 9 under 35 U.S.C. 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is withdrawn." (emphasis added). Due to the lack of a specific rejection and the indication that the rejection is withdrawn, Applicants cannot respond.

Under the discussion of Allowable Subject Matter, the examiner argues that the various Het groups set forth in claim 2 "each belongs to a different chemical family, with different chemical structures and properties. All these are drawn to separate inventions and patents."

However, as the examiner points out, more than one species of an invention, not to exceed a reasonable number, may be specifically claimed in different claims in one national application, provided the application also includes an allowable claim generic to all the claimed species and all the claims to species in excess of one are written in dependent form. In the present case, claim 1 is a generic claim covering a core structure with a Het variable at a specific position on the structure of Formula (I). Claim 2 further limits the definition of the Het group by specifically identifying a reasonable number (15) of hetero groups.

According to MPEP 803.02:

Since the decisions in *In re Weber*, 580 F.2d 455, 198 USPQ 328 (CCPA 1978) and *In re Haas*, 580 F.2d 461, 198 USPQ 334 (CCPA 1978), it is improper for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention. *In re Hamisch*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980); and *Ex parte Hozumi*, 3 USPQ2d 1059 (Bd. Pat. App. & Int. 1984). Broadly, unity of invention exists where compounds included within a Markush group (1) share a common utility, and (2) share a substantial structural feature essential to that utility. (Paragraph 3)

In applications containing a Markush-type claim that encompasses at least two independent or distinct inventions, the examiner may require a provisional election of a single species prior to examination on the merits...Following election, the Markush-type claim will be examined fully with respect to the elected species...If the Markush-type claim is not allowable, the provisional election will be given effect and examination will be limited to the Markush-type claim and claims to the elected species, with claims drawn to species patentably distinct from the elected species held withdrawn from further consideration. (Paragraph 4)

On the other hand, should the examiner determine that the elected species is allowable, the examination of the Markush-type claim will be extended. (Paragraph 6)

Further, the examiner needs to consider the compounds as a whole, not just the Het variable. According to MPEP 2173.05(h):

Where a Markush expression is applied only to a portion of a chemical compound, the propriety of the grouping is determined by a consideration of the compound as a whole, and does not depend on there being a community of properties in the members of the Markush expression.

In the present case, Unity of Invention does exist as the compounds of Formula (I) (1) share a common utility, and, considering the compounds as a whole, (2) share a substantial structural feature essential to that utility. Since the examiner has determined that the subject matter of the elected species is allowable, the examiner should, in accordance with MPEP §803.02, extend the examination to the extent necessary to determine patentability.

In view of the above arguments, Applicants respectfully submit that the rejection under 35 U.S.C. §112 is moot or has been overcome and hereby request that this application be passed to issue.

As this response is submitted within three months from the mailing date of the Office Action, a 1-month extension of time is included herewith.

However, in the event the undersigned is mistaken in his calculations, an appropriate extension of time to respond is respectfully requested, and the Commissioner is authorised to debit the appropriate fee for that extension, or any other fee, from the deposit account of the undersigned, no 50-1676 in the name of Syngenta Crop Protection, Inc.

Respectfully submitted,

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